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In re Application of :
BAMERT, Hans Joachim :
Application No.: 09/856,390 :
Filing Date: 22 May 2001 :
Attorney Docket No.: BAMERT-1 PCT :
For: DEVICE FOR HOLDING THE LOG :
TRANSMITTER OF A BOAT :
SPEEDOMETER :

DECISION

This decision is in response to applicant's "Petition" filed in the United States Patent and Trademark Office on 04 August 2003.

BACKGROUND

On 17 October 2000, applicant filed international application PCT/EP00/10189. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 April 2001. The twenty month period for paying the basic national fee in the United States expired on 21 June 2001.

On 22 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a preliminary amendment. The preliminary amendment amends the specification to "claim priority under 35 U.S.C. §120 of PCT/EP00/10189, filed on 17 October 2000."

On 13 July 2001, USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the translation was defective for the reasons indicated on the attached Notice of Defective Translation (Form PCT/DO/EO/913). The Notice of Defective Translation indicated that the number of claims in the International Application and the number of claims in the translations were not the same.

On 13 September 2001, applicant filed "Response to Notification of Missing Requirements Under 35 USC 371," accompanied by fifteen claims in German and a translation of those claims.

On 10 October 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective as the number of claims in the International Application and the number of claims in the translation were not the same and that the processing fee for late furnishing of the translation and a translation of the application were required.

On 13 November 2001, applicant submitted "Response to Notification of Defective Response," accompanied by a translation.

On 05 December 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective because it was marked up.

On 05 June 2002, applicant submitted "Petition Under Section 711.03(c) - Section 2 and Response to Notification of Defective Response," accompanied by a translation and docket printouts.

On 08 July 2002, the Office mailed "Notification" indicating that the application contained conflicting instruction and would be processed as a 35 U.S.C. §111(a) application.

On 04 August 2003, applicant submitted the instant petition.

DISCUSSION

The transmittal letter (Form PTO-1390) filed on 22 May 2001 identified the application as "a filing under 35 U.S.C. 371." However, the transmittal letter (bottom margin) and the preliminary amendment claim benefit under 35 U.S.C. §120 to the PCT application. Applicant's benefit claim under §120 to the international application is inconsistent with a filing under U.S.C. §371. Since applicant gave conflicting instructions, the papers were considered filed under 35 U.S.C. §111(a).

Applicant argues that the 35 U.S.C. §120 claim is not a conflicting instruction. 35 U.S.C. §120 allows for claims to prior filed applications, by either 111(a) filings or international applications. Applicant claimed priority to the international application as a prior filed application. By doing so, applicant indicated that the 22 May 2001 submission was a different application from the international application filed 17 October 2000. A 35 U.S.C. 371 application is the international application and does not claim priority to itself.

Applicant argues that its 111(a) application will be rejected based on applicant's published international application. This is not the case. Applicant is entitled to claim benefit under 35 U.S.C. §120 and §365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/856,390) and the international application (PCT/EP00/10189) designating the United States were copending on 22 May 2001.

CONCLUSION

For the above reasons, the petition submitted 04 August 2003 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper

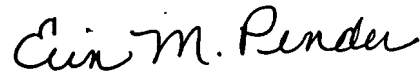
response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration. As of 01 October 2004, the undersigned may be reached at 571-272-3292 and PCT Legal Administration's facsimile number will be 571-273-0459.

This application is being returned to Art Unit 3617 for further processing .



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